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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/086,014	02/28/2002	Andrea Hughs-Baird	0112300-610	3796

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EXAMINER
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MOSSER, ROBERT E

ART UNIT	PAPER NUMBER
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3714

DATE MAILED: 10/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/086,014

**Applicant(s)**

HUGHS-BAIRD ET AL.

**Examiner**

Robert Mosser

**Art Unit**

3712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 01 August 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-18, and 20-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 11-17, 21 and 22 is/are allowed.
- 6) ☒ Claim(s) 1-10, 18 and 20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 8-01-2006.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**



**Claims 1-18 and 20-22 are pending.**



***Terminal Disclaimer***

The terminal Disclaimer filed in this application on October 12<sup>th</sup>, 2005 was approved hence the previous presented rejections under double patenting and USC 103 have been withdrawn.

***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on February 28<sup>th</sup>, 2006 has been entered.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-10, 18, and 20 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for awarding a selection, does not reasonably provide enablement for paying a selection. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make or use the invention commensurate in scope with these claims. The specification as originally filed provides for the awarding of an offer to the player however the Applicant now uses and argues the term paying as proposed distinction between the presently claimed invention and the prior art as applied. As this term is relied upon for by the Applicant to provide a distinction from the prior art in their remarks dated August 1<sup>st</sup>, 2006 and there appears to be no prior support for this distinction in the application as originally filed.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims **1-10 18**, and **20** are rejected under 35 U.S.C. 102(e) as being anticipated by Baerlocher et al (US 6,648,754)

[The content of section below entitled, Response to Arguments is incorporated herein]

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Regarding at least claim **1**, Baerlocher et al teaches a gaming device having a game comprising:

A plurality of values (equivalently offers) greater than zero and payable to the player (See grid Figure 4b & Elm 112, 120 );

A plurality of player selectable masked selections (Elements 108a-108x);

An input device (Elements 44, 50);

A memory device storing a plurality of instructions (Elements 44, 46, 48);

A display device (Figure 1, & Elements 30, 32); and

A processor adapted to communicate with the display device and input device (Figure 2), said processor operable to execute said instructions to operate with said display device and said input device for each play of the game (Col 5:31-51):

(a) directly and individually associate said values with said selections (Col 6:47-51);

(b) enable a player to select one of said selections (Col 6:47-51);

(c) reveal the value/offer directly and individually associated with the selected selection to the player (Col 6:47-51);

(d) enable the player to accept or reject the revealed value (Col 6:52-63); and

(e) repeat steps (a) through (d) at least once if said player rejects said revealed value, wherein if the player rejects said revealed values/offers, said revealed value is directly and individually re-associated with one of said masked selections for at least one subsequent selection of step (a) (Col 10:30-44).

(f) if the player accepts said revealed offer, paying said revealed offer to the player (Col 7:5-16)

Regarding claims 2-3, the plurality of values are randomly selected and associated with game selections (Col 7:40-61) from a pool of offers wherein the "pool" of offers includes all tangible game offers.

Regarding claims 4, 7 and 9, Baerlocher shows in the grid of figure 4b a number of offers equal to the number of selections. Wherein a step number is associated with each possible selection shown and the instant language "number of offers" is met by the multiple presentation of a single value (Figure 23, Element 108. "23"). Additional claim language in claim 9 stating, "each said offer" is not equivalent to "each unique offer" and hence fails to separate from the prior art of Baerlocher.

Regarding claim **5**, Baerlocher may be considered alternatively to teach the inclusion of a number of values greater than the number of selections in the realization of "the present invention includes not associating or placing one or more possible steps" (Col 7:45-50).

Regarding claims **6** and **10**, Baerlocher may be considered alternatively to teach the inclusion of a number of values less than the number of selections. Wherein a step number is associated with each possible selection shown in figure 4b contains the use of repeated specific values such as the number 23 (Col 7:40-60). Hence as understood this can be interpreted as a number of unique values less than the number of selections.

Regarding claim **8**, Baerlocher teaches the re-association (reshuffling) of values with selection after the user rejects one selection (Col 10:29-44).

Regarding at least claim **18**, Baerlocher et al teaches a gaming device having a game wherein each play of said game comprises:

- (a) triggering a play the game (Col 6:8-39);
- (b) directly and individually associating a plurality of offers with a plurality of selections, such that each offer is directly and individually associated with a separate one of the selections, wherein said plurality of offers are each payable to the player (Col 6:47-51 & Col 7:5-16);
- (c) displaying a plurality player available selections (Figures 4-5);
- (d) revealing one of said offers directly and individually associated with the said selections to the player (Col 6:47-51 & Figure 5b);

- (e) enabling the player to select/pick one of the selections (Col 6:47-51) ;
- (f) revealing one of said offers directly and individually associated with the respective player picked/selected selection to the player (Col 7:29-39 & Figure 4);
- (g) enabling the player to accept or reject said revealed offer (Col 6:47-51);
- (h) providing the offer to the player if the player accepts said offer or if the offer is the last offer(Col 7:5-16); and
- (i) repeating steps (b) through (h) if the player rejects said offer and the offer is not the last offer, wherein if the player rejects said revealed offer, for said repeat of step (b) said revealed offer is directly and individually reassociated with one of said selections for at least one subsequent selection by the player (Col 10:30-44).

Regarding claim **20**, the apparatus/method of Baerlocher teaches revealing a singular value associated with each selection and hence this singular value must represent the maximum and minimum offer (Figure 4).

### ***Response to Arguments***

Applicant's arguments filed August 1<sup>st</sup>, 2006 have been fully considered but they are not persuasive.



The Applicant continues to argue for a separate definition of an *offer* presented to the player for acceptance and rejection and a *value* presented to the player for acceptance or rejection. This point has been argued now by the applicant in their responses entered on August 1<sup>st</sup>, 2006, February 28<sup>th</sup>, 2006, and January 23<sup>rd</sup>, 2006. The Applicant's most recent rebuttal of August 1<sup>st</sup>, 2006 the Applicant contends that this interpretation is a contradiction to the well-established precedent that claims must be interpreted in view of their associated specification. The precedent for this interpretation however maybe in MPEP section 2111 wherein the importation of the specification into the claims has been found to be repeatedly improper. In this instance the Applicant's claimed *offer* does encompass *values* while the step of presenting values to the player for the player's acceptance and rejection does define an *offer* (exemplary claim 18 step (f) as originally filed further defines a value as an offer). This matter is not presently correlated to issues of patentability and accordingly held as being redressed.

On page 11 of the remarks by Applicant the Applicant contends that the present claims include a *direct* and *individual* association between a selection and the value associated with said selection and that this relationship defines the claimed invention over the previously presented first interpretation. Respectfully the Applicant is interpreting this new claim language of a narrower scope then presented. A direct and individual association as utilized in the presented claims sets forth only a minimum of a one to one correspondence between a selection and a value but not a sole, unique or unrepeated relationship. By way of a brief example the selection elements A' and B' can both be directly and individually associated with the common value 3 hence while

the player's selection of A' or B' may result in the achievement of the value of 3, the selection of A' does not imply the selection of B' and nor would the selection of B' imply the selection of A'.

On page 11 of the remarks by Applicant the Applicant contends that the present claims include the feature of paying elements to the player not provided for in the previously presented second interpretation. While it is noted the prior art does set forth a set of paying an award separate from the steps (Col 7:5-16) it additionally refers to the accrual of steps. These steps are awarded and equivalently paid through out the play of the game and shown as Steps Accrued (Elm 112). While these steps are later redeemed for an associated reward corresponding to the number of steps accrued in the time between the awarding of these steps and their redemption they are none the less the result of the player's action throughout the game and contain an intermediate value in so much as they are eventually redeemed for a credit value prize.

#### ***Allowable Subject Matter***

Claims **11-17** and **21-22** are allowed.

#### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within

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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Mosser whose telephone number is (571)-272-4451. The examiner can normally be reached on 8:30-4:30 Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hotaling can be reached on (571) 272-4437. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



MARK SAGER  
PRIMARY EXAMINER

REM